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Paper No. 13

HRW

11/27/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Studner Enterprises, Inc.

Serial No. 75/380,198

Leon I. Edelson for Studner Enterprises, Inc.

Christine M. Baker, Trademark Examining Attorney, Law
Office 106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Studner Enterprises, Inc. has filed an application to
register the mark BARNACLE'S RESTAURANT & LOUNGE for
"restaurant services."¹

Registration has been finally refused under Section
2(d) on the ground of likelihood of confusion with the mark

¹ Serial No. 75/380,198, filed October 27, 1997, claiming a date
of first use of September 1983 and a date of first use in
commerce of September 1985. A disclaimer has been entered of the
words RESTAURANT & LOUNGE.

BARNACLE'S SEAFOOD, OYSTERS & SPORTS and design, in the form depicted below, which is registered for "restaurant/bar."²

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*³ factors which are relevant under the circumstances at hand. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

² Registration No. 2,171,068, issued July 7, 1998, claiming first use dates of March 22, 1993. A disclaimer has been made of the words SEAFOOD, OYSTERS & SPORTS. As pointed out by the Examining Attorney, although the registration issued in Class 41, the correct class for the recited services is Class 42.

³ See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Looking to the marks, we agree with that Examining Attorney that the dominant part of both applicant's and registrant's marks is the word BARNACLE'S. While it is true that marks must be considered in their entirety in determining likelihood of confusion, it is also well established that there is nothing improper in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although disclaimed matter cannot be ignored, the fact remains that consumers are more likely to rely on the non-descriptive portion of the mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). Moreover, if one of the marks comprises both words and a design, the words are normally accorded greater weight because the words are what would be used by consumers to request or refer to the services. This is particularly true when restaurant services are involved, since consumers are often likely to patronize restaurants on the basis of word-of-mouth recommendations. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Here, the descriptive wording RESTAURANT & LOUNGE in applicant's mark has little or no significance as an indicator of a particular source. It is simply the generic

term for an establishment of this type. The specimens themselves demonstrate that consumers would refer to applicant's restaurant as BARNACLE'S. (See comment, "Loved it, you need to put a Barnacles [sic] in West Virginia"). In registrant's mark the wording SEAFOOD, OYSTERS & SPORTS merely describes the type of food available, along with the type of entertainment. This also is a description which would be appropriate for many such establishments and, thus, has little source-indicating significance. It is the word BARNACLE'S which is the portion of each mark which would be relied upon as the identifier of the particular source of the restaurant services being provided thereunder. See *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant argues that the design of a clam serving seafood is the distinctive feature of registrant's mark, and cannot be ignored in viewing the marks as a whole. While we agree that this design feature must be considered in comparing the marks in their entirety, we also are thoroughly convinced that it is the word BARNACLE'S by which consumers would refer to registrant's restaurant/bar services and not a description of the clam holding a beer and a plate of seafood. Although the design may be eye-

catching, it is not the dominant portion of the mark for purposes of source-identification.

Accordingly, when the respective marks are considered in their entirety, we find that, although there are obvious differences in appearance and sound, both marks are dominated by the word BARNACLE'S and, as a result, create highly similar commercial impressions.

Turning to the services, we agree with the Examining Attorney that applicant's restaurant services and registrant's restaurant/bar services are identical. Despite the fact that the cited registration issued in Class 41, the restaurant services recited in the registration are the same as applicant's services. Furthermore, it is obvious from applicant's mark that its restaurant also features a lounge or bar.

Applicant has also raised the issue of the lack of actual confusion, with applicant's assertion of use of its mark since 1983 and registrant's claim of use since 1993. This factor can be given little probative weight, however, because registrant has not had the opportunity to be heard from on this point. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). Although applicant points out that it is located in Ormond Beach, Florida, whereas registrant's restaurants are purportedly located in

Atlanta, Georgia, any present geographic separation in the area of use of the marks is irrelevant.⁴ Federal registration creates the presumption that registrant has the exclusive right to use its mark throughout the United States. See *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401 (Fed. Cir. 1991). This is not a concurrent use proceeding in which the issue of concurrent registrations with geographic limitations as to areas of use is taken under consideration. See Trademark Rule 2.133(c).

Finally, applicant argues that applicant has earlier dates of first use and first use in commerce than those claimed by registrant. Priority of use, however, is not germane to the determination of an applicant's right to register in an ex parte proceeding. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971). Any challenge to the cited registration must be raised in a cancellation proceeding.

Accordingly, in view of the similarity of commercial impressions of the respective marks and the use thereof in

⁴ Applicant has attached portions of the file history of the cited registration to its brief. This evidence is untimely under Trademark Rule 2.142(d) and will not be considered. Although the Examining Attorney did not raise an objection thereto, she did not address the evidence on the merits. Even if we considered the evidence, we would reach the same decision on the case.

Ser No. 75/380,198

connection with identical restaurant services, we find
confusion likely.

Decision: The refusal to register under Section 2(d)
is affirmed.

T. J. Quinn

B. A. Chapman

H. R. Wendel

Administrative Trademark Judges,
Trademark Trial and Appeal Board

Ser No. 75/380,198